

The Examiner objected to the present disclosure "because it does not contain an indication that this application is a continuation..." The present application has been amended herein so as to include an indication thereof.

Claims 2, 5-10, 12, 16, and amended claims 1 and 4 are in this application.

Claims 1, 2, 4-10, 12, and 16 were rejected under 35 U.S.C. 102(e) as being anticipated by Knee et al. (5,589,892).

Amended independent claim 1 recites in part as follows:

"An apparatus for controlling display of an electrical program guide, comprising: broadcast program information storage means for storing, as broadcast information, the information relative to number of broadcast programs extracted from predetermined positions of video signals;

recorded program information storage means for storing, as recorded program information, the information relative to a number of broadcast programs previously recorded in a recording medium..."(Underlining added for emphasis)

Accordingly, in claim 1, information relative to a number of broadcast programs which were previously recorded in a recording medium may be stored in a storage means. As an example, such information may include a cassette number and program data signifying the identities and start positions of a number of programs previously recorded on a cassette.

In explaining the above 35 U.S.C. §102(e) rejection, the Examiner apparently asserted that Knee (and in particular, col. 36, lines 52-61 thereof) discloses the present recorded program information storage means and the Examiner stated that Knee "could also be configured to use other stored schedule information for this purpose, such as recorded program information".

The following comments are submitted in response to the Examiner's rejection based on Knee.

First, the recorded program information storage means of claim 1 does not appear to be described in the portion of Knee relied upon by the Examiner (hereinafter "Knee"). That is, Knee appears to disclose storing "a unique digital identifier for each program"(line 53 of column 36) in which the identifier could be used "to indicate to a recording or storage device, such as a video recorder, that the user wishes to record the program"(col. 36, lines 55-57).

(Underlining added for emphasis)

Accordingly, Knee does not disclose storing recorded program information relative to a number of broadcast programs that have been previously recorded in a recording medium.

Second, with regard to Examiner's assertion that it would have been obvious to modify the teachings of Knee, reference is made to In re Fritch, (23 USPQ 2d 1780-CAFC 1992) in which the Court states at page 1783:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so'. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". (Underlining added for emphasis.)

There is no suggestion in Knee, as required by the Court In Re Fritch, to modify Knee in the manner suggested by the Examiner so as to obtain recorded program information

storage means which may store information that is relative to a number of broadcast programs previously recorded as set forth in claim 1.

Therefore, claim 1 is believed to be distinguishable from Knee.

For reasons similar to those described above with regard to claim 1, independent claim 4 is also believed to be distinguishable from Knee.

Claims 2, 5-10, 12, and 16 are dependent from one of independent claim 1 and 4 and, due to such dependency, are also distinguishable from Knee for at least the reasons previously described.

It is to be appreciated that the foregoing comments concerning the disclosures in the cited prior art represent the present opinions of the applicants' undersigned attorney and, in the event, that the Examiner disagrees with any such opinions, it is requested that the Examiner indicate where, in the reference or references, there is the basis for a contrary view.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable over the prior art, and early and favorable consideration thereof is solicited.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By:


Dennis M. Smid
Reg. No. 34,930
(212) 588-0800